

## REMARKS

### **Claim Status**

Prior to this amendment, claims 1-69 were pending in the instant application, with claims 41-57 being withdrawn. With this amendment, claims 14, 15, 17, 35, 36, 38, 41 and 49 have been amended. Upon entry of this amendment, claims 1-69 will be pending in the instant application, with claims 41-57 remaining withdrawn.

Support for the amendments can be found throughout the specification, including claims 1, 13, 14, 15, 17, 20, 34, 35, 36 and 38 of the application as originally filed, and at page 4, lines 3-10, of the specification. No new matter is added by this amendment to the claims. Accordingly, entry into the instant application is proper and respectfully requested.

### **Double Patenting**

Claims 1-40 and 58-69 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-33, 58-62, and 94-101 of U.S. Application No. 10/005,529. Applicants respectfully traverse this rejection.

Applicant submits that U.S. Application No. 10/005,529 issued as U.S. Patent No. 7,142,987 on November 28, 2006. The issued claims of the '987 patent are directed to methods of preparing an archive sample for analysis; the issued claims correspond to originally filed claims 63-93 and 102-115. Originally filed claims 1-33, 58-62, and 94-101 of U.S. Application No. 10/005,529, which are directed to sample archive systems, a computer readable medium, and a sample node removal system, respectively, were cancelled during prosecution. The cancellation of claims 1-33, 58-62, and 94-101 of the '529 application renders this rejection moot. Accordingly, Applicant requests that this rejection be withdrawn.

Claims 1-40 and 58-69 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-30 of U.S. Application No. 10/150,770. Applicants respectfully traverse this rejection.

Applicant submits that the '779 application has been abandoned, rendering this rejection moot. Accordingly, Applicant requests that this rejection be withdrawn.

Claims 1-40 and 58-69 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-64 and 86-114 of co-pending U.S. Application No. 10/150,771. Because the claims of U.S. Application No. 10/150,771 currently stand rejected for reasons other than obviousness-type double patenting, Applicant is under no obligation to respond to this rejection at this time.

**Rejections Under 35 U.S.C. § 102**

Claims 1-40 and 58-69 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by WO 01/31333 (Milosavijevic et al.). Applicant respectfully traverses this rejection.

Applicant submits that this ground for rejection was reversed by the Board of Patent Appeals and Interferences at page 5 of the Decision on Appeal dated December 29, 2008. Accordingly, Applicant requests that this rejection be withdrawn.

Claims 1-40 and 58-69 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by WO 01/31317 (Hogan et al.). Applicant respectfully traverses this rejection.

Applicant submits that this ground for rejection was reversed by the Board of Patent Appeals and Interferences at page 5 of the Decision on Appeal dated December 29, 2008. Accordingly, Applicant requests that this rejection be withdrawn.

**Rejections Under 35 U.S.C. § 103**

Claims 15-19, 36-40 and 67-68 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over WO 01/31317 (Hogan et al.). As alleged in Examiner's Answer, at page 5, Hogan teaches a biological retrieval system wherein "the substrate (24) upon which the sample is placed is a paper material [which] has been read on the claimed 'solid', 'porous', and 'cellulose' support medium" and a "punch head assembly (72) [that] punches out a portion of the sample on the substrate (24) into a multi-well tray" where "[t]he claimed nodes have been read on the sample applied to the substrate (24) and the claimed array on the taught multi-well tray." Applicants respectfully traverse this rejection.

In order to establish a prima facie case of obviousness, three criteria must be satisfied. First, some suggestion or motivation to modify a reference or to combine the teachings of multiple references has to be shown. Second, there must be a reasonable expectation of success

regarding the modification or combination. And third, the prior art has to teach or suggest every limitation of the claims. *See KSR Int'l v. Teleflex, Inc.*, 82 USPQ2d 1385 (2007). Applicant respectfully submits that these criteria have not been established in this case.

As set forth at page 4 of the Decision on Appeal dated December 29, 2008, Hogan et al. fail to teach a discrete sample node removably attached to a structural array. Applicant submits that Hogan et al. fail to even suggest a discrete sample node removably attached to a structural array. As set forth in Examiner's Answer, the claimed array is the multi-well tray and the removably attached sample node is a punched out portion of the substrate (24) which contains sample. The purpose for placing the punched out portion of substrate into a well of the multi-well tray is for further processing. *See* Decision on Appeal at page 4. Nothing in Hogan et al. suggests having the punched out portion of substrate reversibly attached to the well. Moreover, because the purpose of placing the punched out portion of substrate placed in a well is for further processing, and, in particular, isolation of nucleic acids from the substrate, one skilled in the art would find no suggestion or motivation, either in the '317 application or the general knowledge in the art, to have the punched-out portions of substrate removably attached to the well.

Accordingly, Hogan et al. fail to teach or suggest every limitation of the pending claims and one skilled in the art would find no motivation or suggestion to modify the device of the '317 application to arrive at the presently claimed invention. For at least these reasons, Applicant respectfully requests that this rejection be withdrawn.

#### **Rejoinder of Withdrawn Claims**

Applicant submits that the foregoing amendments and remarks overcome all of the pending rejections of claims 1-40 and 58-69. Because withdrawn method claims 41-48 contain all the limitations of composition claim 1 and withdrawn method claims 49-57 contain all of the limitations of composition claim 20, Applicant hereby requests rejoinder of withdrawn method claims 41-57. *See* MPEP 821.04(b).

## CONCLUSION

In light of the above amendments and remarks, Applicant respectfully submits that claims 1-69 satisfy all the criteria for patentability and are in condition for allowance. Applicant hereby requests that withdrawn method claims 41-57 be rejoined at this time, and further requests that the Examiner reconsider this application with a view towards allowance and early passage of claims 1-69 to issuance. The Examiner is invited to call the undersigned attorney, if a telephone call could help resolve any remaining items.

Pursuant to 37 CFR § 1.136(a)(3), the Commissioner is hereby authorized to charge all required fees, including fees under 37 CFR § 1.17 and all required extension of time fees, or credit any overpayment, to Deposit Account No. 50-1283.

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Respectfully submitted,

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